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PTO/SB/21 (07-06)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/614,550
	Filing Date	July 7, 2003
	First Named Inventor	Robert G. Metzger
	Art Unit	3738
	Examiner Name	Christopher D. Prone
Total Number of Pages in This Submission	Attorney Docket Number	5490-000209/CPA

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Pre-Appeal Brief Request for Review with 5-supplemental pages attached; return postcard		
<table border="1"><tr><td>Remarks</td><td>The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.</td></tr></table>			Remarks	The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Richard W. Warner	Reg. No.	38,043
Signature					
Date	September 13, 2006				

CERTIFICATE OF TRANSMISSION/MAILING

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PTO/SB/33 (07-06)

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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
5490-000209/CPA

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
10/614,550Filed
July 7, 2003First Named Inventor
Robert G. Metzger

On 9-13-06

Signature

Art Unit
3738Examiner
Christopher D. Prone

Typed or printed name Carol Naumann

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 38,043

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Richard W. Warner
Typed or printed name248-641-1600
Telephone numberSeptember 13, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/614,550
Filing Date: July 7, 2003
Applicant: Robert G. Metzger
Group Art Unit: 3738
Examiner: Christopher D. Prone
Title: ELONGATED FEMORAL COMPONENT
Attorney Docket: 5490-000209/CPA

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REMARKS/ARGUMENTS INCLUDED WITH A PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully submit that there are clear errors in the rejection set forth in the Office Action mailed June 13, 2006. Specifically, the cited art fails to disclose each and every feature of the claims. As a result, the Office Action fails to set forth a prima facie rejection of the pending claims. Therefore, this Pre-Appeal Brief Request For Review is necessary and proper.

The Pending Claims

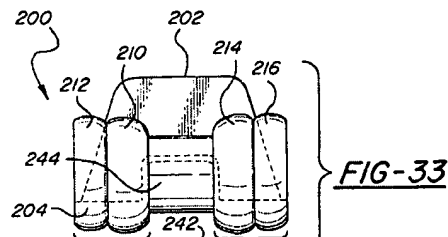
All pending claims stand rejected under 35 U.S.C. § 102(b) in light of Pottenger et al. (U.S. Patent No. 6,039,764). Independent Claims 1, 10, 18, and 24 each recite, in part, “a knee joint prosthesis system.” This system comprises “a first femoral component” and a “second femoral component” each having different maximum medial to lateral dimensions. The first and second femoral components, as defined by the independent claims and disclosed in the specification, are two separate and distinct femoral components. The Final Office Action’s citation to Pottenger et al, which discloses a single femoral component having two different condyle regions, as anticipating the claimed “first femoral component” and “second femoral component” is clear error.

Remarks and Arguments

The Final Office Action, mailed June 13, 2006, rejected all of the pending claims under Section 102 based on Pottenger et al. The Final Office Action based its rejection on the following:

Pottenger discloses the invention substantially as claimed being modular knee joint system comprising first and second femoral components (214) and (216)....

6-13-06 Office Action at 2. The relevant portion of Figure 33 from Pottenger et al. that the 6-13-06 Office Action is referring to is provided below.



Thus, the Final Office Action asserts that the elements at reference numerals 214 and 216 of the Pottenger et al. reference, which are different portions of a condyle portion of a single femoral component, anticipate the claimed system comprising a “first femoral component” and a “second femoral component.”

The Final Office Action, for the first time and contrary to the 12-27-05 Non-Final Office Action, asserts that the claimed “first femoral component” and the “second femoral component” are anticipated by two different portions of a single femoral component. **This is clear error.**

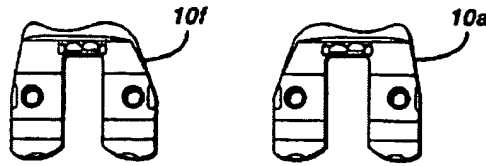
The claimed “first femoral component” and “second femoral component” refer to two separate and distinct femoral components, one of which can be selected by a surgeon for implantation in a patient. The claimed “first femoral component” and “second femoral component” are **not** two areas of a single femoral component as disclosed by Pottenger et al.

12-27-05 Non-Final Office Action

In the 12-27-05 Non-Final Office Action the Examiner acknowledged that the claimed “first femoral component” and the “second femoral component” indeed refer to two separate and distinct femoral components. In the Non-Final Action the Examiner rejected the pending claims under Section 103 in light of Colleran et al. (U.S. Patent No. 5,776,201). The Non-Final Action based its rejection on the following:

Colleran discloses the invention substantially as claimed being modular knee joint system comprising **first and second femoral components (10a) and (10f).**...

12-27-05 Office Action at 2 (emphasis added). The relevant portion of Figure 4 of Colleran et al. that the Office Action is referring to is provided below.



Thus, the 12-27-05 Office Action acknowledged that the claimed “first femoral component” and “second femoral component” are separate and distinct femoral components by comparing the two claimed femoral components to the components illustrated in Colleran at 10a and 10f. Therefore, the Non-Final Office Action also shows that the Examiner considered the “first femoral component” and the “second femoral component” to be separate and distinct when searching the invention.

The Specification

The specification supports no other conclusion than that the claimed system comprising a “first femoral component” and a “second femoral component” are separate and distinct femoral components. For example, paragraph [0043] recites that each femoral component includes “a first condylar portion 38 and a second condylar portion 40 that provides a first femoral bearing surface 42 and a second femoral bearing surface 44, respectively.” These are features of a typical femoral component operable to be implanted in a patient.

Further, paragraph [0066] recites, with reference to Figures 10 and 11 for exemplary purposes only, “The present invention gives a surgeon the ability to choose a femoral component for a knee joint prosthesis from a variety of different femoral components, such as the CR femoral 32a and 32b, that have a varying M/L dimension and a constant anterior/posterior dimension allowing constant femoral engagement.”

As set forth in the specification and as illustrated in the figures, the first femoral component and the second femoral component are two separate components, one of which can be selected by a surgeon

for implantation. Therefore, the Final Office Action's rejection of the claims based on the single femoral component of the Pottenger reference is clear error.

The Dependent Claims

The fact that the first and second femoral components are two distinct femoral components that can be selected by a physician for implantation in a patient is also set forth in the dependent claims which, through the doctrine of claim differentiation, further define the independent claims.

For example, dependent Claim 6, recites, "wherein said first femoral component is a first cruciate femoral component and said second femoral component is a second posterior stabilized (PS) femoral component." Claim 7 recites, "wherein said first femoral component is a first cruciate femoral component and said second femoral component is a second fully constrained femoral component."

As set forth in the specification, cruciate femoral components, posterior stabilized (PS) femoral components, and fully constrained femoral components are each separate and distinct types of femoral components that accommodate the needs of different patients. For example, a fully constrained femoral component is used when a patient has severe soft tissue damage or loss and a posterior stabilized (PS) femoral component is used when the patient has an intermediate level of soft tissue damage, as is known in the art. If both the first femoral component and the second femoral component is a single femoral component, as the Examiner asserts, then the single femoral component would also have to be both a fully constrained femoral component and a PS femoral component, which is not possible as is known in the art.

A single femoral component cannot be more than one of a cruciate femoral component and a PS femoral component, or a fully constrained femoral component. Paragraphs 39, 43, 53, and 57 and Figure 2 describe and illustrate some of the differences between these different femoral components. Even if these different femoral components are interpreted broadly, as the June 13, 2006 Office Action indicates, a single femoral component again cannot be both a cruciate femoral component and a posterior stabilized femoral component or a fully constrained femoral component.

Dependent Claims 3 and 13 recite "a tibial component." Use of the term "component" in Claims 3 and 13 again refers to a separate and distinct component from the first and second femoral components of the independent claims. The Final Office Action acknowledges this fact by comparing the claimed tibial component to the separate tibial component at reference numeral 230 of Pottenger et al. Thus, the Office Action's interpretation of "component" with respect to the independent claims is inconsistent with the interpretation of the dependent claims reciting a "tibial component."

Conclusion

As set forth above, Applicants respectfully submit that the rejection based on the Pottenger et al. reference is clear error. The specification, claims, knowledge of one skilled in the art, and Applicants' remarks made herein and throughout prosecution, indicate that the claimed "system" comprising a "first femoral component" and "second femoral component" are two separate femoral components. The claimed "first femoral component" and "second femoral component" cannot be different regions of the same femoral component, as the Final Office Action asserts. The 12-27-05 Office Action even confirms this fact by comparing the claimed "first femoral component" to a separate first femoral component 10f of Colleran and the claimed "second femoral component" to a separate second femoral component 10a.

The cited art fails to disclose or suggest a "first femoral component" and a "second femoral component" having different maximum medial to lateral dimensions, as set forth in independent Claims 1, 10, 18, and 24. Therefore, the Final Office Action fails to set forth a prima facie case under Section 102. In light of this clear error and failure to set forth a prima facie rejection, Applicants respectfully request that the Section 102 rejection based on Pottenger et al. be withdrawn.

Respectfully submitted,

Dated: Sept. 13, 2006

By: Richard Warner
Richard Warner 38,043

HARNES, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600